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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,935	01/02/2004	Philip S. Siegel	067439.0158	1902
5073	7590	06/14/2007		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER SHAAWAT, MUSSA A	
			ART UNIT 3627	PAPER NUMBER
			NOTIFICATION DATE 06/14/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com  
ptomail1@bakerbotts.com

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/750,935		SIEGEL, PHILIP S.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mussa A. Shaawat		3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/04, 3/18/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This communication is in response to Application #10/750935, filed on January 02, 2004. Claims 1-27 are pending examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17-18, 21 and 26-27 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

72.  
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Claim 17-18, 21 and 26 recite **computer product**, which do not fall within the four statutory classes of 101. Computer product is non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like. Appropriate corrections are required to overcome the 101 rejections.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6-8, and 10-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Arganbright et al, US Patent No. (6,980,962) referred to hereinafter as Arganbright.

Claim 1: Arganbright teaches a method of using a computer system for on-line processing of merchandise returns, comprising the steps of: receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise,(see col.63 8-11); and processing the return in accordance with one or more return rules associated with the merchandise (see col. 1-10, user reviews the satisfaction guarantee rules).

Claim 2: Arganbright teaches a method of claim 1, wherein the receiving step is performed via an Internet access tool associated with the customer, (see col.63 lines 5-8).

Claim 3: Arganbright teaches a method of claim 1, wherein the processing step is preceded by the steps of storing the return rules in a database and of matching the item to the stored rules, (see col.63 lines 8-11, where user reviews the satisfaction guarantee rules he then decides if he wants to return or exchange the merchandise i.e. matching the item to the stored rules in the database).

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Claim 6: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining disposition of the item, (see col.63 lines 1-10).

Claim 7: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining a shipping destination of the item, (see col.63 lines 29-31).

Claim 8: Arganbright teaches the step of notifying a merchant of the return item, (see col. 63 lines 18-22).

Claim 10: Arganbright teaches a method of claim 1, further comprising the step of electronically delivering data about the customer to a merchant associated with the return, (see col.46 lines 35-53).

Claim 11: Arganbright teaches a method of claim 1, further comprising the step of providing a user interface to the customer, via an Internet access tool, wherein the user interface displays information associated with return of one or more items purchased by the customer, (see col.63 lines 1-11).

Claim 12: Arganbright teaches a method of claim 11, wherein the user interface displays a list of transactions associated with the customer, listing items for potential return by the customer, (see col.63 lines 1-11).

Claim 13: Arganbright teaches a method of claim 1, further comprising the step of downloading a return label to the customer via the Internet, (see col.63 lines 23-35).

Claim 14: Arganbright teaches a method of claim 1, further comprising the step of notifying a shipping agent of the return, (see col.63 lines 23-35).

Claims 15-27, the limitations of claims 15-27 are similar to the limitations of claims 1, 3, 8, and 10, therefore claims 15-27 are rejected based on the same rationale.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

Claim 4: Arganbright does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious

to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Claim 5: official notice is taken regarding the old and notorious practice of giving notice to customer that the request has been rejected and is made final. See e.g. US6192347 par. 517.

Claim 9: official notice is taken regarding the old and notorious practice of crediting an account of the customer.

#### ***Cited references***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

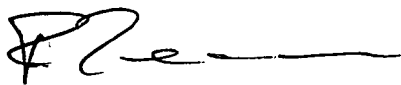
#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat  
Patent Examiner  
June 4, 2007

 6/6/07  
F. RYAN ZEENDER  
SUPERVISORY PATENT EXAMINER